



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 29

BRIAN F. RUSSELL
DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN TX 78759

COPY MAILED

FEB 06 2008

OFFICE OF PETITIONS

In re Application of :
Timothy Skergan : DECISION ON PETITION
Application No. 08/353,008 :
Filed: December 9, 1994 :
Attorney Docket No. AT993110 :

This is a decision on the "RENEWED PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)" filed July 16, 2007.

The petition is **GRANTED**.

By Notice of Abandonment mailed November 30, 2001, applicant was advised that the application was abandoned as a result of failure to take appropriate action in a timely manner after the decision rendered on June 19, 2001 (not May 19, 2001 as stated in the notice) by the Board of Patent Appeals and Interferences. Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(c). The notice stated as no claim was considered allowed, the application became abandoned.

On initial petition, petitioner stated that they did not respond to the notice because claims did stand allowed. Thus, the application was not abandoned and should have passed to issue on the allowed claims 6-9.

By decision mailed July 9, 2007, the initial PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR §1.137(b) filed April 2, 2007 was noted. It was noted that further action was required by the examiner with respect to claims 6 through 9.

More importantly, the instant application was filed on December 9, 1994, and the instant petition was filed on April 2, 2007, more than 5 years after the mailing of the notice of abandonment on November 30, 2001. As stated in MPEP 711.03(c),

37 CFR 1.137(d) requires, in pertinent part, that a petition under either 37 CFR 1.137(a) or 1.137(b) be accompanied by a terminal disclaimer (and fee), regardless of the period of abandonment, in:

...

(B) a nonprovisional utility application (other than a reissue application) filed before June 8, 1995

Alternatively, 37 CFR 1.181(f) also provides that, inter alia, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may require a terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment.

Accordingly, a terminal disclaimer was required. It was further noted that the terminal disclaimer filed April 2, 2007 (with the disclaimer fee) was not proper.

On instant renewed petition, applicants filed a proper terminal disclaimer signed by an attorney of record.

It is undisputed that the instant petition was filed more than five years after this application was deemed abandoned and a notice of abandonment was mailed. This is substantially beyond

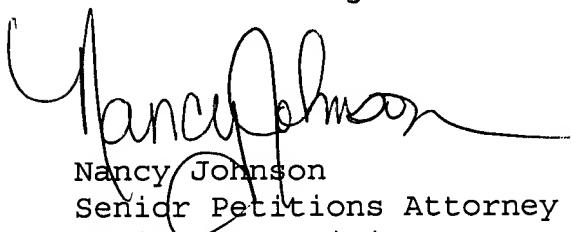
the two-month period for timely filing a petition to withdraw the abandonment. Moreover, it is undisputed that the instant application was filed prior to June 8, 1995. Accordingly, under the circumstances, regardless of the propriety of the original determination of abandonment, entry of a terminal disclaimer is appropriate for revival of this application (or for withdrawal of the holding of abandonment). Petitioner has also paid the petition fee for revival and made the required statement of unintentional delay. Moreover, petitioner has stated the specific circumstances of the entire delay to support a conclusion that the abandonment was unintentional. Applicant previously met the required reply element by taking appropriate action in response to the Board Decision. No action was required on the part of applicant.

In view thereof, the petition to revive is GRANTED.

Receipt of the change of correspondence address filed July 16, 2007 is acknowledged and made of record.

The application is being forwarded to the Technology Center's technical support staff for processing of the Terminal Disclaimer filed July 16, 2007 (Paper No. 27) and for further action by the examiner consistent with this decision. The examiner's attention is directed to the Board Decision of June 19, 2001.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.


Nancy Johnson
Senior Petitions Attorney
Office of Petitions